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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/659,430	09/08/00	VANCURA	O 2000/4

EXAMINER	
ARYANPOUR, M	
ART UNIT	**PAPER NUMBER**
3711	5

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DATE MAILED: 05/21/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/659,430	Oalf Vancura
Examiner	**Art Unit**
Mitra Aryanpour	3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Mar 8, 2001

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-32 is/are pending in the applica

4a) Of the above, claim(s) _____ is/are withdrawn from considera

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-32 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirem

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on Sep 8, 2000 is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

Oath/Declaration

1. The instant application does not contain a proper power of attorney for Charles McCrea, Jr. Applicant has merely stated to direct all correspondence to : Charles McCrea, Jr., but has failed to provide customer number for Mr. McCrea, Jr. It appears that Mr. McCrea, Jr. is, acting in a representative capacity under 37 CFR 1.34, i.e.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "the casino game of chance with random entry from an underlying slot machine to a bonus game" and "the structure in the casino game of chance to control the house advantage" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show "start position and finish position", "die", "flipping a coin", "random number generator", "a base and a bonus game" as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

On pages 4, 7 and 11-14 the flow charts should be incorporated in the drawings and not in the specification. Correction is requested.

Claim Objections

The term "square or squares" has been changed in claim 1 to "position or positions", however the remaining dependent claims still contain the term "square or squares". Correction is requested.

4. Claim 1 is objected to because of the following informalities: line 5, "paths" should be --path--; line 10, "along path selected by the player" should be --along a selected path by the player--.

5. Claim 8 is objected to because of the following informalities: line 3, "of positions includes using a stop position" it is unclear what is meant my the above sentence.

6. Claim 11 is objected to because of the following informalities: line 6, "with a provided" should be --provided with a--; line 12, "probably" should be --probability--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, there is no recitation of where the wager or bet is imputed

In claim 1, line 3, "playing in a casino" has not been positively recited.

In claim 1, line 7, "c) affording with the random means . . ." it is unclear what is meant by this sentence.

9. Claim 1 recites the limitation "the house advantage" in line 14; "the random frequency" in line 15. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 12 recites the limitation "the house advantage" in line 10; "the random frequency" in line 11. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 17 recites the limitation "the player selected path" in line 6; "the overall house advantage" in line 9;"the random frequency" in lines 10-11;"the bonus game" in line 11. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 32 recites the limitation "the selected path" in line 8; "the house advantage" in lines 14-15; "the random frequency" in lines 15-16; "the bonus game" in line 16; "the value of each position" in line 17; "the expected monetary or credit value" in lines 17-18. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that

the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 1-7, 9-12, 14-25 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (4,887,819) in view of Harris et al (4,930,789).

Regarding claims 1, 2, 10, 12, 15, 17-20, 28 and 30-32, Walker discloses a method of playing a game in conjunction with a slot machine comprising a path having a plurality of squares (see Figure 1). Walker teaches establishing a random means of traversing the path while awarding the player the values associated with squares landed thereon (see column 10, lines 35-40 and 64-66); Walker further teaches providing a "croupier or attendant at a gaming table" for handling the casino bank, paying, receiving and exchanging chips, basically for controlling the house advantage of the casino game (column 6, lines 35-49).

Walker as described above lacks (a) a plurality of paths, (b) allowing a player to select one of the paths, (c) each path having a start and an end position. The functional recitations, the intended use of the game as a base game or bonus game, have not been given patentable weight since the prior art shows the structural limitations and these limitations are not limited to one method of play.

Harris shows a game employing a plurality of intersecting paths (see Figure 1). The player, when meeting a certain requirement, is also allowed to select a given path (see column 6, lines 33-37).

Walker defines a path that inherently has two ends (see Figure 1, numerals 101 and 144). Walker has claimed a path that has a general racetrack shape (see column 11, lines 53 and 54).

Walker also teaches that the shape of the path as depicted in Figure 1 can be changed and the path can have greater or lesser number of boxes (see column 10, lines 58-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Walker's casino board game to include additional paths such as the ones described by Harris et al, in order to create a more challenging game for the players.

Regarding claims 3-7 and 21-25, Walker shows that the dice can be used as a random chance device (see column 10, lines 64-66). Using a spinner, rotating wheel, coin flipping or random number generators are considered equivalent chance devices in the game art. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. *Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

Regarding claims 9, 14 and 27, Walker shows certain squares (or positions) causing additional movement (see column 3, lines 61-65).

Regarding claims 11, 16 and 29, Walker shows establishing squares (or positions) having associated games (see column 3, lines 36-49).

15. Claims 8, 13 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art, as applied to claims 1, 12 and 17 above, and further in view of Wilkins et al et al (5,810,359).

Walker as modified above meets the claimed invention except specifying a "stop" position.

Wilkins et al shows a marked action space that has no effect equivalent to a "stop" position (see Figure 1, numeral 20).

Moreover, Walker teaches the use of cards to effect no gaming action by losing a turn to other player (see column 5, line 55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a space into the game board that corresponds to no gaming action for adding a extra chance element to the game play.

Response to Arguments

16. Applicant's arguments filed 03/08/01 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.

Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, to combine Walker with Harris et al would enhance the game at the same time provide a more simulating game.

In response to applicant's argument that Walker and Harris et al are non-analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references (Walker and Harris et al) describe a "casino board game", which meet the limitations of the subject invention. The claims merely suggest that it is "a method for playing in a casino game".

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is (703) 308-3550. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

MA

May 11, 2001

JEANETTE CHAPMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700